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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,151	02/11/2002	Su-Chen Fan	JCLA5041-CA2	1029

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EXAMINER

VERSTEEG, STEVEN H

ART UNIT

PAPER NUMBER

1753

5

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,151

Applicant(s)

FAN, SU-CHEN

Examiner

Steven H VerSteeg

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1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,7,9 and 11-13 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/417,357.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the serial number for the parent application is incorrect on page 1 beginning at line 4; also, the status of both the parent and grandparent applications needs updated.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 5 and 6 contain new matter. Specifically, the limitation “substantially higher than the second bias” in claim 5 and performing the metal film formation and the dry cleaning and amorphizing in “different chambers for claim 6 could not be located in the specification as originally filed and are thus considered to be new matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,360,765 to Kondo et al. (Kondo) in view of US 5,178,739 to Barnes et al. (Barnes).

6. For claim 1, Applicant requires a method for treating a silicon substrate comprising: placing the substrate into a sputtering chamber, performing a sputtering step to simultaneously dry clean and amorphize the substrate surface using a first sputtering chamber, and depositing a titanium film on the amorphized silicon substrate by using the same chamber wherein the sputtering chamber is an ionized metal plasma equipment. For claim 2 Applicant requires the titanium film to be deposited at about 540°C.

7. Kondo discloses a method for forming electrodes (abstract). The method involves providing a silicon substrate 1. The substrate is processed in a sputtering system (Figure 2). The system contains a chamber 23. In the chamber, there is an etching station 13 and a sputtering station 15 for forming titanium (col. 4, l. 56-58). At the etching station, the silicon substrate is subjected to argon gas to dry-clean the substrate and amorphize the silicon by sputtering (col. 4, l. 33-55). As can be seen from Figure 2, both processes are performed in the same sputtering chamber 23. Kondo indicates that the titanium is deposited at a temperature of about 500°C, which is about 540°C.

8. Kondo does not indicate that the argon is ionized and that titanium atoms sputter from the target and deposit on the substrate (col. 4, l. 63-67). Therefore, Kondo does not teach IMP.

9. Barnes discloses that when sputtering, it is advantageous to utilize an RF coil in the chamber because it will result in a high density plasma and ionize sputter neutrals which allows the plasma to be more evenly distributed throughout the chamber (col. 2, l. 59-63). The benefit

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of an evenly distributed plasma is that the uniformity of the deposition can be controlled (col. 3, l. 1-3).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kondo to utilize a coil in the chamber because of the desire to control the uniformity of deposition. The use of the coil will result in IMP.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claim 10 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,254,739 B1. This is a double patenting rejection.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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14. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,254,739 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims is that the claim of the application does not require the specifics of the bias and the steps after the titanium layer is formed. However, all of the limitations of claim 1 of the application are present in claim 4 of the patent. Therefore, claim 1 of the application is obvious.

Allowable Subject Matter

15. Claims 4, 7, 9, and 11-13 are allowed.

16. The following is a statement of reasons for the indication of allowable subject matter: it is neither anticipated nor obvious over the prior art of record to have a method for treating a silicon substrate as claimed by Applicant in claim 4 wherein a first bias is applied to the argon and a second bias is applied to the substrate, a titanium layer is formed, an annealing step is then performed to react the titanium layer with the silicon substrate, and then removing the titanium that didn't react. The closest prior art, Kondo, performs the reaction of the titanium with the silicon substrate while forming the titanium, not in a separate annealing step. Applicant's background of the invention discloses a similar process, but does not disclose simultaneously dry cleaning and amorphizing. The two references are not combinable because there is no motivation to utilize the process of Applicant's prior art to alter the process of Kondo or vice versa.

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General Information

For general status inquiries on applications not having received a first action on the merits, please contact the Technology Center 1700 receptionist at (703) 308-0661.

For inquiries involving Recovery of lost papers & cases, sending out missing papers, resetting shortened statutory periods, or for restarting the shortened statutory period for response, please contact Palestine Jenkins at (703) 308-3521.


For general inquiries such as fees, hours of operation, and employee location, please contact the Technology Center 1700 receptionist at (703) 308-0661.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H VerSteeg whose telephone number is (703) 305-4473. The examiner can normally be reached on Mon - Thurs (7:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Steven H VerSteeg
Primary Examiner
Art Unit 1753

shv
April 10, 2003